

REMARKS

The Office Action mailed May 24, 2004 has been carefully reviewed along with the references cited therein. In the Office Action, the Examiner rejected claim 19 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The Examiner also rejected claims 1, 3, 5-8, 10, 14 and 17-19 under § 102(e) as being anticipated by U.S. Patent Application Publication No. US2003/0139225 (Rife). The Examiner also rejected claims 1 and 2 under § 102(b) as being anticipated by U.S. Patent No. 6,200,228 (Takeda) or U.S. Patent No. 5,328,175 (Yamada). The Examiner rejected claims 14-15 under § 102(b) as being anticipated by U.S. Patent No. 6,099,414 (Kusano). The Examiner also rejected claims 4 and 9 under § 103(a) as being unpatentable over Rife in view of Takeda. The Examiner rejected claim 11 under § 103(a) as being unpatentable over Rife in view of Official Notice and U.S. Patent No. 5,665,009 (Sherwood). The Examiner took official notice that a golf club having a shaft is well known to one skilled in the art. The Examiner rejected claim 12 under § 103(a) as being unpatentable over Rife in view of the Official Notice and U.S. Patent No. 5,665,009 Sherwood as applied to claim 11 and in further view of U.S. Patent No. 6,695,937 (Stites) in view of U.S. Patent No. 4,848,747 (Fujimura). Claim 13 was rejected under § 103(a) as being unpatentable over Rife in view of the Official Notice and Sherwood as applied to claim 11 and further in view of Takeda. Claims 14-16 were rejected under § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0043830 (Imamoto) in view of the Official Notice.

In this amendment, Applicant has canceled claims 1-5, amended claims 6 and 7, canceled claim 8, amended claims 9 and 10, canceled claims 11-13, amended claim 14, canceled claim 15, amended claims 16 and 19 and added claims 20-26. Claim 20 has been added to the application and includes similar limitations as original claims 2, 3, 5 and 8. Claim 21 has been added to the application and depends from claim 20. Claims 22-26 have been added to the application to better protect the invention. Claims 6, 7, 9 and 10 have been amended so that they now depend from new claim 20. Claim 14 has been amended to define over the cited references. Claim 16 has been amended so that it now depends from claim 14. Claim 19 has been amended to remedy the § 112, second paragraph rejection.

Claim 20 recites, among other things, that the muscle back portion defines "a cavity that is not visible from the exterior of the golf club." This is similar to the limitation

recited in original claim 2, which was rejected as being anticipated by Takeda or Yamada. Claim 20 also recites that the rear surface includes a blade surface "being near the top edge and substantially parallel to the front surface." This limitation is similar to original claim 5 which was rejected as being anticipated by Rife. According to the Examiner's rejections in the subject Office Action, the Examiner would be required to combine Rife with Takeda or Yamada in order to sustain a rejection for new claim 20.

Applicant respectfully submits that there is no motivation to combine Rife with Takeda or Yamada to provide the club head of Rife where the cavity is not visible from the exterior of the golf club. Rife is directed to a combination blade type iron and peripheral weight iron. Rife recognizes that "blade type iron construction may be formed with a muscle back type bulge." See paragraph [0001]. However, Rife discloses fourteen different embodiments of combination blade/peripheral weight irons and in each of those embodiments the cavity is visible from the exterior of the golf club. Furthermore, in the embodiment depicted in FIGS. 14 and 15, Rife forms the rear cavity with sides 832 that undercut to facilitate retention of the insert 830. By providing these sides Rife seems to be contemplating never having a rear surface to hide the cavity 826 because a rear surface would retain the insert 830 obviating the need for any undercut. Rife does not disclose any motivation to provide a golf club where the cavity is not visible from the exterior of the golf club. Accordingly, it would be improper to combine Rife with Takeda or Yamada such that the cavity in Rife would not be visible from the exterior of the golf club.

Also, claim 20 recites a blade surface, a muscle back surface and that the blade surface is substantially parallel to the front surface. Both Takeda and Yamada fail to disclose a golf club head that includes such a blade surface, nor do they provide any motivation to modify to include such a blade surface. Takeda is directed to integrating a plurality of members made from different metal into a golf club. See col. 1, lines 5-10. Takeda makes no mention of a blade or blade surface. FIG. 16 in Takeda, the figure upon which the Examiner based the rejection of original claims 1 and 2, simply discloses a hollow iron, which is well known in the art.

Yamada also fails to disclose the blade surfaces as recited in claim 20, which the Examiner recognized in the subject Office Action. Yamada is directed to a golf club head having a main body made from one material and a face member made from a second material. Nowhere does Yamada provide a motivation to include the blade surface recited in claim 20.

In view of the above, it is submitted that claim 20, and those claims that depend from claim 20 patentably define over the cited references.

Claim 21 patentably defines even further over the cited references. Claim 21 recites "an elastomer material at least substantially filling the cavity, wherein the elastomer material has a specific gravity less than the material displaced by the cavity." This limitation is similar to original claims 4 and 8. Original claim 4 was rejected over Rife in view of Takeda. The Examiner indicated that Takeda discloses a cavity having a filling of polyurethane at column 5 lines 1-3. Applicant was unable to locate a polyurethane filling disclosed in Takeda. Takeda discloses a back member 9 fitted into a cavity 8. The back member is described as titanium or titanium alloy or an aluminum or aluminum alloy. In view of this, Applicant respectfully submits that claim 21 patentably defines over the references cited by the Examiner.

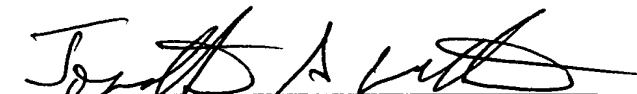
Claim 14 has been amended to include the limitation of original claim 15 and to further define the back as "having an upper portion substantially parallel to the face." Original claim 15 was rejected as being anticipated by Kusano. Kusano fails to disclose a back having an upper portion substantially parallel to the face. Accordingly, claim 15 defines over Kusano.

Claim 14 was also rejected in view of Imamoto; however, Imamoto also fails to disclose an upper portion substantially parallel to the face. The upper portion in Imamoto projects outward like that of a perimeter weighted club head. Accordingly, claim 14 as amended also defines over Imamoto.

In view of the above, it is submitted that the pending claims patentably define over the cited references. Accordingly, the application is in condition for allowance. An early notice to that affect is earnestly solicited.

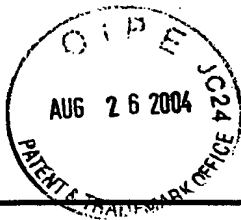
Respectfully submitted,

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August 23, 2004
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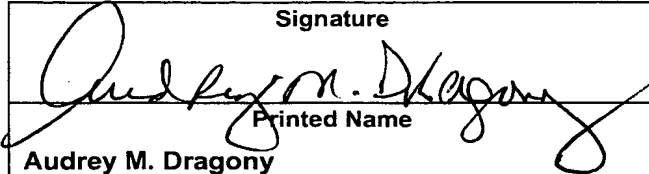


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